



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,196	12/31/2003	Donald M. Berlin	1751.1001	6739
21171 7590 02/22/2007 STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER LE, MIRANDA	
			ART UNIT 2167	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/22/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/748,196

Applicant(s)

DONALD BERLIN

Examiner

Miranda Le

Art Unit

2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This communication is responsive to Amendment, filed 11/21/2006.
2. Claims 1-17 are pending in this application. Claims 1, 10, 17 are independent claims. In the Amendment, claims 1, 10, 17 have been amended. This action is made Final.

The rejection of claims 1-17 by 35 U.S.C. §101 has been withdrawn in view of the amendment.

The objection to the specification (drawings, claim objection) of the invention has been withdrawn in view of the amendment.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless:

(e) the invention was described in

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 10-13 are rejected under 35 U.S.C. 102(e) as being anticipated by De Breed (US Patent No. 6,944,628).

Breed anticipated independent claim 10 by the following:

Art Unit: 2167

As per claim 10, De Breed teaches a computer-implemented method of identifying a person, comprising:

given non-uniquely identified target names and target ages/addresses corresponding to target persons (*i.e. name, telephone numbers, fax number and/or postal codes, col. 1, lines 25-30*), and using a comprehensive public record dataset produced by combining multiple disparate public record databases of data of a general population including the target persons (*i.e. the addresses from the database are linked to publicly accessible data, col. 1, lines 43-35*), automatically determining with substantial certainty that a target name corresponds with a particular unique individual in the general population, thereby identifying the person corresponding to the target name and delivering that determination. (*i.e. the method for processing and/or sending one or more e-mail messages in electronic manner, wherein the addresses of people and/or organizations are stored in a database, and wherein the addresses from the database are linked to publicly accessible data such as name, telephone numbers, fax number and/or postal codes, col. 1, lines 31-38*).

As per claim 11, De Breed teaches a method according to claim 10, wherein the determining is based only on the target name and target age/address (*i.e. name, telephone numbers, fax number and/or postal codes, col. 1, lines 25-30*).

As per claim 12, De Breed teaches a method according to claim 10, wherein the determining is done without a key or identifier uniquely identifying the target person among the general population and by using the public record dataset to link the target person to the

Art Unit: 2167

particular individual in the general population (*i.e. A preferred embodiment of the method for processing and/or sending one or more e-mail messages in electronic manner, wherein the addresses of people and/or organisations are stored in a database, and wherein the addresses from the database are linked to publicly accessible data such as name, telephone numbers, fax number and/or postal codes, col. 1, lines 31-38*).

As per claim 13, De Breed teaches a method according to claim 12, wherein the key or identifier comprises a social security number or an identifier that serves as a proxy therefore (*i.e. If using an internet site a data set is available or made accessible in which all publicly known data of private individuals and/or organisations is stored, anyone who so wishes can link his e-mail address thereto in a manner which is visible or invisible to the sender of a message, col. 1, lines 43-55*).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-9, 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Breed (US Patent No. 6,944,628), in view of Tanner (US Pub No. 20040243588).

As to claims 1, 17, De Breed teaches a method of delivering a non-uniquely identified name that substantially corresponds to a uniquely identified person, the method comprising:

accessing a source dataset (*i.e. database, col. 1, lines 25-30*) of uniquely identified persons (*i.e. addresses of people and/or organizations are stored in a database, col. 1, lines 25-30*), the dataset comprising records comprising, for each uniquely identified person, a source name, a source unique identifier, a source date of birth, and a source address;

accessing a target dataset (*i.e. publicly accessible data, col. 1, lines 25-30*), not derived from the source dataset, of non-uniquely identified persons, the dataset comprising records comprising, for each non-uniquely identified person, a target name (*i.e. name, telephone numbers, fax number and/or postal codes, col. 1, lines 25-30*);

for a particular source person in the source dataset, and in accordance with the accessing the target dataset, automatically whether the particular source person corresponds to a particular target person in the target dataset (*i.e. the addresses from the database are linked to publicly accessible data, col. 1, lines 43-35*) and delivering the determination (*i.e. the method for processing and/or sending one or more e-mail messages in electronic manner, wherein the addresses of people and/or organizations are stored in a database, and wherein the addresses*

Art Unit: 2167

from the database are linked to publicly accessible data such as name, telephone numbers, fax number and/or postal codes, col. 1, lines 31-38).

De Breed does not specifically teach a target age, and a target age-date indicating an exact or approximate date age.

However, Tanner teaches a target age, and a target age-date indicating an exact or approximate date age (*i.e. a date of birth, or an age of the person; or unique personal information such as the name of a spouse or maiden name; or any other personal identification information or business identification information, [0055]*).

It would have been obvious to one of ordinary skill of the art having the teaching of De Breed and Tanner at the time the invention was made to modify the system of De Breed to include the limitations as taught by Tanner.

One of ordinary skill in the art would be motivated to make this combination in order to administer customer inquiry requests for information in view of Tanner, as doing so would give the added benefit of enabling a third-party to initiate a new account with a customer, a name or other information associated with the third-party can be part of an inquiry request that is automatically transmitted by the customer or a system associated with the customer as taught by Tanner (*[0055]*).

As per claim 2, Tanner teaches a method according to claim 1, wherein the automatically determining comprises matching a target identifier in the target dataset with an identifier of the particular source person when the identifier of the particular source person is available, whereby the uniquely identified particular person is determined to correspond to the particular target

person (*i.e. filtering potential matching records and removing at least some false positives; determining positive matching records in the global information database to the inquiry requests, [0026]*)).

As per claim 3, Tanner teaches a method according to claim 2, wherein the automatically determining further comprises matching the date of birth and name of the particular source person with the particular target person based on the name, the target age, and the target age-date of the particular target person, whereby the uniquely identified particular person is determined to correspond to the particular target person (*i.e. An inquiry request can include, but is not limited to, a person's name, a business or company name, an entity name, in combination with location information such as city, state, or zip code; or unique numerical identification information such as a social security number, a federal tax ID number, an account number, a date of birth, or an age of the person; or unique personal information such as the name of a spouse or maiden name; or any other personal identification information or business identification information, [0055]*)).

As per claim 4, Tanner teaches a method according to claim 3, wherein the automatically determining further comprises matching the address of the particular source person with the address of the particular target person, whereby the uniquely identified particular person is determined to correspond to the particular target person (*i.e. An inquiry request can include, but is not limited to, a person's name, a business or company name, an entity name, in combination with location information such as city, state, or zip code; or unique numerical identification*

Art Unit: 2167

information such as a social security number, a federal tax ID number, an account number, a date of birth, or an age of the person; or unique personal information such as the name of a spouse or maiden name; or any other personal identification information or business identification information, [0055]).

As per claim 5, Tanner teaches a method according to claim 4, wherein the automatically matching of addresses further comprises determining that the particular source person and the particular target person both have an address common to a set of current/previous addresses of the particular source person, where the set of current/previous addresses are obtained separately from and keyed to the source dataset (*i.e. first name, last name, age, address, date of birth, date of information, employment, position, and other associated information, [0318]*).

As per claim 6, Tanner teaches a method according to claim 5, wherein the automatically determining further comprises determining a uniqueness of the source name of the particular source person, and based on the uniqueness, determining whether the source name corresponds to the target name of the particular target person (*i.e. The Person/Company name filter can identify at least four types of records: a Person Name, Person Record (PNPR), in which the record has a person's name and is a person's record; Person Name, Business Record (PNBR), in which the record has a person's name but is a business record; Business Name, Business Record (BNBR), in which the record has a business name and is a business record; and Business Name, Person Record (BNPR), in which the record has a business name but is a person's record, [0180]*).

As per claim 7, Tanner teaches a method according to claim 6, further comprising automatically finding one or more persons who have co-resided with the particular source person using another dataset (*i.e. The Person/Company name filter can identify at least four types of records: a Person Name, Person Record (PNPR), in which the record has a person's name and is a person's record; Person Name, Business Record (PNBR), in which the record has a person's name but is a business record; Business Name, Business Record (BNBR), in which the record has a business name and is a business record; and Business Name, Person Record (BNPR), in which the record has a business name but is a person's record, [0180]).*

As per claim 8, Tanner teaches a method according to claim 7, wherein the automatically finding of one or more persons who have co-resided with the particular person is based on whether the one or more persons have lived at the particular person's source address for a predetermined period of time (*i.e. new daily grey file, [0097]*), and is based on whether the one or more persons have lived at two consecutive current/previous addresses in the set of current/previous addresses of the particular source person (*i.e. any other entity that desires to track information related to a particular person, name, [0056]*).

As per claim 9, Tanner teaches a method according to any of claims 1 through 8, wherein the target dataset comprises a set of officers or directors of publicly traded companies, wherein the source dataset comprises a set of potential market participants, and wherein the determining of a correspondence between the particular source person and the particular target person indicates a substantial likelihood that the particular source person is a market participant

that is also an officer or director of a publicly traded company (*i.e. Fair Credit Reporting Act (FCRA) and non-FCRA related data, published data, customer-supplied data, public information, and private information, [0099]*).

As per claim 14, De Breed does not teach a method according to claim 10, wherein the determining is based on at least one of a date of birth of the particular individual, a degree of uniqueness of the target name, and a set of previous/former addresses of the particular individual.

However, Tanner teaches a method according to claim 10, wherein the determining is based on at least one of a date of birth of the particular individual, a degree of uniqueness of the target name, and a set of previous/former addresses of the particular individual (*i.e. generate a ranking or sequential order for the reduced or qualified list of potential matches depending upon the quality, quantitative value, or confidence level of the potential match, [0131]*).

It would have been obvious to one of ordinary skill of the art having the teaching of De Breed and Tanner at the time the invention was made to modify the system of De Breed to include the limitations as taught by Tanner.

One of ordinary skill in the art would be motivated to make this combination in order to administer customer inquiry requests for information in view of Tanner, as doing so would give the added benefit of when having a third-party initiates a new account with a customer, a *name* or other information associated with the third-party can be part of an inquiry request that is automatically transmitted by the customer or a system associated with the customer as taught by Tanner (*[0055]*).

As per claim 15, De Breed does not explicitly teach a method according to any of claims 10 through 14, wherein the target persons comprise officers or directors of publicly traded companies.

However, Tanner teaches the target persons comprise officers or directors of publicly traded companies (*i.e. Fair Credit Reporting Act (FCRA) and non-FCRA related data, published data, customer-supplied data, public information, and private information, [0099]*).

It would have been obvious to one of ordinary skill of the art having the teaching of De Breed and Tanner at the time the invention was made to modify the system of De Breed to include the limitations as taught by Tanner.

One of ordinary skill in the art would be motivated to make this combination in order to administer customer inquiry requests for information in view of Tanner, as doing so would give the added benefit of when having a third-party initiates a new account with a customer, a *name* or other information associated with the third-party can be part of an inquiry request that is automatically transmitted by the customer or a system associated with the customer as taught by Tanner (*[0055]*).

As per claim 16, Tanner teaches a method according to claim 15, wherein the determining of a correspondence between the particular unique individual in the general population with the target name indicates a substantial likelihood that the particular unique individual is an officer or director of a publicly traded company (*i.e. generate a ranking or sequential order for the reduced or qualified list of potential matches depending upon the quality, quantitative value, or confidence level of the potential match, [0131]*).

Response to Arguments

7. Applicant's arguments regarding Tanner does not anticipate claims 1, 10, 17 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Miranda Le whose telephone number is (571) 272-4112. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cottingham, can be reached on (571) 272-7079. The fax number to this Art Unit is (571)-273-8300.

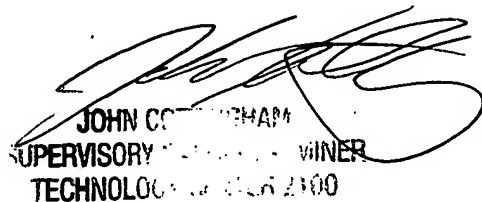
Art Unit: 2167

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Miranda Le
February 16, 2007



JOHN C. WINEM
SUPERVISORY TECHNOLOGICAL CENTER
TECHNOLOGICAL CENTER 2100